

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

Claims 6-9 and 12-43 are presently pending in the application. Claims 6-9 have been withdrawn from consideration due to the election made earlier in the prosecution of this application. The Examiner has considered claims 12-43.

As an initial matter, the Examiner has requested copies of the references cited in the parent case and not now cited in the present case. Those references which were cited in the parent case were identified by the Applicant on the 1449 filed on December 10, 1997. Although the Applicant has no objection to providing a copy of those references, it is noted that a copy of the references is no longer available within the Applicant's files. The Applicant could obtain a copy at the Patent Office, but believe it would be more expedient for the Examiner to obtain those copies in the parent application held at the U.S. Patent Office. Accordingly, Applicant respectfully requests the Examiner to obtain a copy of the references cited on the 1449 in the parent application or otherwise from the U.S. Patent Office. Should the Examiner insist on a copy being submitted, Applicant will go through the trouble and expense to obtain that copy and provide them to the Examiner. The Examiner's assistance in this matter is appreciated.

The Examiner has requested a more detailed Abstract. Accordingly, Applicant submits herewith a newly revised Abstract for the Examiner's consideration. The Abstract is believed to conform with the U.S. law, and reconsideration by the Examiner is requested.

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

Next, the Examiner has objected to the drawings under Rule 83(a). The Examiner contends that the drawings do not show the indicia on the box "body" but rather only on the cover. Applicant respectfully traverses this objection.

Although Fig. 1 illustrates the rectangular section or indicia shown on the cover of the box body in Fig. 1, the Examiner is directed to Fig. 3 which shows a box body having the indicia formed thereon. Thus, Applicant respectfully submits that the application as originally filed supports the recitation of an indicia being on the cover or the box body. In fact, it is immaterial whether the indicia is indicated on the cover or body, as long as the indicia is located on the box containing the golf balls.

Nevertheless, Applicant has amended the claims to recite that the label is placed on the package. Here, the package in its broadest sense may include the cover, box body or both.

Accordingly, Applicant respectfully traverses this objection and request reconsideration in view of the amendments to claim 1.

Turning to more substantive issue:

Claims 12-43 stand rejected under § 112, second paragraph, as being indefinite. The Examiner's rejection is based in part on the same reasons that the drawing objection were based. For the reasons set forth above, reconsideration and withdrawal of the § 112, second paragraph, rejection is respectfully requested.

The Examiner also contends that the number of claims is excessive and confusing for the subject matter. Applicant respectfully disagrees.

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

Claims 12-43 include essentially two sets of claims, based on independent claims 12 and 31. Claims 12-30 are directed to a package for receiving a golf ball, and require the indication section to be formed on the box for indicating a plurality of performance characteristics of the golf ball. The section includes two or more sub-sections, each of which includes an icon and a first set of descriptive information to identify and specify a performance characteristic of the golf ball. In contrast, claim 31 requires first and second sub-sections. The first sub-section is similar to the sub-section recited in claim 12, but is limited to representing a first performance characteristic of the golf ball. The second sub-section includes a second icon and second set of descriptive information representative of the second performance characteristic of the golf ball. Thus, claim 31 is more detailed than claim 12 of the present application. Claims 13-30 which depend on 12 and claims 32-43 which depend on 31 are used to fill in the finer details of the present invention and to define the invention more fully. Applicant respectfully submits that the two sets of claims when considered in this manner are not excessive or confusing.

Next, the Examiner rejects claims 12-43 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 5,713,803. Applicant respectfully traverses this rejection.

A careful analysis of the two sets of claims reveals that claims 1-18 of the '803 patent are quite more detailed than those set forth in the present application. Indeed,

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

the Examiner even recognizes there are differences in the claims when asserting the obviousness type double patenting rejection.

Moreover, in contrast to the claims of the present application (i.e., claims 12-43), claim 1 of the '803 patent, for example, recites that the section is divided longitudinally and transversely into a plurality of sub-sections, that the longitudinally or transversely adjacent sub-sections are grouped into a plurality of functional groups representative of both the performance and construction characteristics of the golf ball, and that the functional groups include at least two of ball structure, recommended head speed, feel, spin rate, green targeting, and trajectory. The definition of the sub-sections as recited in claim 1 of the '803 patent is also more detailed and directed to a different embodiment or feature of the invention than the pending claims of the present application.

Thus, there are substantial differences in terms of scope between the claims of the '803 patent and the claims presently pending in the present application and which stand rejected by the Examiner under § 101.

For all of the foregoing reasons, Applicant respectfully traverses the rejection of claims 12-43 under 35 U.S.C. § 101. Reconsideration and withdrawal of this rejection, together with the rejection under the judicially created doctrine of obviousness-type double patenting, are respectfully requested in view of the reasons stated above.

The Examiner further rejects claims 12-43 under § 102(a) as being anticipated by Connell, and under § 103(a) as being unpatentable over Taylor in view of Connell. These rejections are respectfully traversed.

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

Connell teaches labels for use with smoking pipes, having a label that is suitable for cartons or boxes which may be packed of any variety of styles or shapes of smoking pipes. The label is adapted for designating the characteristics of a particular style of a pipe. (See, column 1, lines 8-17.)

In contrast to the present invention, Connell fails to teach or suggest an indication section for indicating a plurality of performance characteristics of a golf ball. The section includes two or more sub-sections, each of which includes an icon and a first set of descriptive information to identify and specify the performance characteristics of the golf ball. In Connell, the labels merely identify the quantity and types of pipes enclosed in the carton. The information displayed does not convey information concerning the characteristics of the pipe. As an example, in the present invention, characteristics of the golf ball include spin rate, feel, trajectory, green targeting and so on. The indication sections provide a representative icon and descriptive information to specify this type of performance characteristic. Connell does not teach or suggest these features of the present invention.

The addition of Taylor also does not teach or suggest the invention. Taylor simply discloses a golf ball made according to a certain specification. There is no teaching or suggestion in Taylor that would make up the deficiencies of Connell, as noted above.

Accordingly, for all of the foregoing reasons, Applicant respectfully submits that the claims of the present application, claims 12-43, are neither anticipated by Connell

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 08/988,181**

nor rendered obvious by the combination of Taylor and Connell when viewed in combination together. Reconsideration and withdrawal of this rejection are respectfully requested.

The application is now believed to be in order. However, should any issues remain, the Examiner is requested to contact the undersigned attorney at the local telephone exchange listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case.

Respectfully submitted,

  
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